

REMARKS

Claims 1-9, 12-24, 27, and 28 are currently pending in the application. Claims 1, 8, and 21 are in independent form.

Applicant wishes to express his appreciation for the courtesies extended Applicant's representative, Amy E. Rinaldo, during a telephonic interview conducted on December 15, 2003.

The Office Action states that the drawings are objected to because they fail to show how the position indicator arm is attached to the shoulder pad. Reference to the drawings is needed because of claims 10 and 11. In order to further prosecution, claims 10 and 11 have been canceled without prejudice. Reconsideration of the rejection is respectfully requested.

Claims 1-10 and 12-24 stand rejected under 35 U.S.C § 103(a) as being unpatentable over the Mingo patent in view of the Cole, Lazier, and Oppenheimer patents. Reconsideration of the rejection under 35 U.S.C. §103(a) over the Mingo patent in view of the Cole, Lazier, and Oppenheimer patents, as applied to the claims, is also respectfully requested.

It is Hornbook Law that before two or more references may be combined to negative patentability of a claimed invention, at least one of the references must teach or suggest the benefits to be obtained by the combination. This statement of law was first set forth in the landmark case of Ex parte McCullom, 204 O.G. 1346; 1914 C.D. 70. This decision was rendered by Assistant Commissioner Newton upon appeal from the Examiner-in-Chief and dealt with the matter of combination of references. Since then many courts have over the years affirmed this doctrine.

The applicable law was more recently restated by the Court of Appeals for the Federal Circuit in the case of ACS Hospital Systems, Inc. v. Montefiore Hospital, 732

F.2d 1572,1577, 221 U.S.P.Q. 929 (Fed. Cir. 1984). In this case the Court stated, on page 933, as follows:

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103 teachings of references can be combined only if there is some suggestion or incentive to do so. The prior art of record fails to provide any such suggestion or incentive. Accordingly we hold that the court below erred as a matter of law in concluding that the claimed invention would have been obvious to one of ordinary skill in the art under section 103."

This Doctrine was even more recently reaffirmed by the CAFC in Ashland Oil, Inc. v. Delta Resins and Refractories, Inc., et al., 776 F.2d 281,297, 227 U.S.P.Q. 657,667. As stated, the District Court concluded:

"Obviousness, however, cannot be established by combining the teachings of the prior art to produce the claimed invention unless there was some teaching, suggestion, or incentive in this prior art which would have made such a combination appropriate."

The Court cited ACS Hospital Systems, Inc. in support of its ruling. This Doctrine was reaffirmed in In re Deuel, 34 USPQ2d 1210 (Fed. Cir. 1995).

The Office Action states that the Mingo patent discloses a golf swing training device that has attachment means for attaching a support member adjacent to a shoulder of the golfer, and shoulder position indicator means is formed of a resilient member. The Office Action acknowledges that the Mingo patent fails to disclose a position indicator means that projects outwardly from the golfer's shoulder. When read more specifically, the Mingo patent discloses a device that holds in place both of the golfer's shoulders. The attachment means are placed in front of both shoulders and a single rod is placed therebetween, parallel to the golfer's body. The device is not visible to the golfer during the swing: Instead, the device merely ensures that the golfer's shoulders stay in proper alignment during the swing. The golfer's shoulders stay in proper alignment because there is a larger rod placed in front of the golfer, thus not

allowing one shoulder to move without the other shoulder moving in a corresponding manner. In contradistinction, the presently claimed invention provides an indicating device that projects outward and forward from the golfer such that the golfer can determine, during the course of his swing, whether the golfer is accurately positioning their shoulders. A visible clue is given to the golfer to determine or detect whether or not the golfer is in proper alignment. The Mingo et al patent does not disclose or suggest the device of the presently pending independent claims.

The Office Action states that the Cole patent discloses a golf swing indicator comprising attachment means for attaching a support member adjacent to the shoulder of a golfer, wherein the support member has a shoulder position indicator means/arm projecting outwardly therefrom and forwardly relative to the golfer, and that the golf training aid is used for indicating the shoulder turn during the takeaway in the back swing. Additionally, the Cole patent discloses an indicator arm that is an elongated member and is substantially perpendicular to the shoulder of the golfer. The indicator arm includes a resilient member and is a device made of a resilient and flexible plastic sheet. The shoulder position indicator means is adjustably secured to the support member using Velcro. Also provided by the Cole patent are position retaining means, an indicator member, a pad, a support member that is located over the forward shoulder of the golfer relative to the swing, attachment means including a harness mechanism, a shoulder position indicator means including a first indicator member that is supported by the indicator arm, and the second indicator member located adjacent to the shoulder of the golfer.

It is undisputed that the Cole patent describes a device indicating "a proper or improper arm orientation" as stated in columns 3 and 4 of the Cole patent. However, one's arms move independently from one's shoulders and therefore the device of the Cole patent does not give an indication of shoulder turn, but merely indicates the position of the arms. The device of the Cole patent is located on the upper arm or leg of a golfer and therefore the movement of the shoulder cannot be determined since it is the movement of the golfer's arms or legs that are being indicated. The cited prior art

does not disclose a device that remains visible to the golfer and that fits on the shoulder of the golfer for indicating proper golf swing.

The present invention solves a problem regarding the ability to provide accurate information of the shoulder turn without giving any indication of arm movement. As described on page 6, lines 29-31, of the present invention, "A typical back swing associated with many mid-to-high handicap golfers may comprise lifting only the arms." The device of the Cole patent will not reveal this problem since the indicator of the Cole patent moves correctly as a result of arm movement, thus indicating that this swing is correct, but the golfer may have an incorrect shoulder turn or no shoulder turn at all.

Additionally, the present invention also indicates the essential transfer weight onto the back foot, which is required for a correct golf swing. Referring specifically to the device of the Cole patent, the disclosed device relies on the relative movement between the indicator and the face of the golfer. See, for example, column 2, which discloses that the device of the Cole patent relies on the indicator being obscured from the vision of the golfer. If one were to take the device of the Cole patent and attempt to use it to indicate the shoulder turn of a golfer, the indicator would need to be positioned at a location that would go out of the vision of the golfer in order to indicate a correct swing. Therefore, one of skill in the art would not place the indicator of the Cole patent projecting forward from the shoulder, since this placement would always remain in the vision of the golfer and would not indicate a correct swing by going out of the vision of the golfer in accordance with the function of the device of the Cole patent. In contradistinction, the device of the present invention as described at page 11, lines 7-13 and 25-29, remains within the golfer's vision and thereby provides more accurate feedback. Additionally, the present invention provides a different method of indicating a correct swing while always remaining visible to the golfer, as opposed to the device of the Cole patent that indicates a proper swing by moving out of the vision of the golfer. By always remaining visible, the feedback is more accurate since once out of the vision of the golfer, the golfer is not made aware of by how much or to what degree the movement is correct or incorrect.

The device of the Cole patent includes a body formed generally as a portion of a cylinder. In order for the device of the Cole patent to fit on the shoulder, it would need to be turned 90° in order for the strap to fasten under the armpit and around the back of the shoulder. In this position, the cylindrical shaped bands could not conform to the shape of the shoulder and would project from the shoulder. This would provide a very insecure attachment to the shoulder and the edges of the cylindrical body would tend to dig into the shoulder. Additionally, the indicator would tend to move relative to the shoulder and would therefore not function so as to reflect the shoulder movement.

With regard to the Lazier patent, the Lazier patent relates to a torso and back rotation indicator that projects from the golfer's back and extends laterally to the golfer's side. As can be seen in Figures 6A-F of the Lazier patent, the indicator is not always visible since it does not project forwardly from the golfer. The main advantage of the present invention is that it projects forwardly from the shoulder of the golfer and thereby indicates the shoulder turn by always remaining visible to the golfer. The cited prior art reference does not disclose a device that remains visible to the golfer and that fits on the shoulder of the golfer for indicating proper golf swing. Since neither the Lazier nor the Cole patent, alone or in combination, teach or suggest the golfer training aid of the present invention, the claims are patentable over the cited prior art references and reconsideration of the rejection is respectfully requested. In order for the Lazier patent to disclose a device that is similar to the presently claimed invention, the Lazier patent would have to be moved to the front of an individual and placed in a completely different position. At present, the Lazier patent discloses a device that cannot be viewed by the golfer as it is placed at the rear of the golfer and is affixed at their back.

The device of the Oppenheimer patent is a generic swing practicing aid that can be utilized for numerous sports including tennis, baseball, and golf. The device of the Oppenheimer patent is a shaft that is centered on the golfer's body. More specifically, the club is directly affixed to the body via the shaft 16. The device provides constraint of the golfer and club throughout the swing. The constraint is obtained because the

distance between points 28 and 30 in the figures is always maintained. However, the affixed distance between the attachment points 26 and 30 of the device of the Oppenheimer patent will not prevent a golfer from picking up the club too steeply at the start of the swing and maintaining the club in this manner throughout the back swing. Thus, the device of the Oppenheimer patent does not correct the problems that can occur during a golf swing.

In contradistinction, the presently claimed invention is a training aid that includes attachment means for affixing the device on the left shoulder of the individual that provides no constraint whatsoever to either the golf swing or the golf club. The device of the presently pending independent claims helps to develop the proper shoulder turn and sets the club in a constant repeatable position at the top of the back swing. The device of the presently pending independent claims does not require the club to be offset to avoid interference with chin at the top of the back swing. The claimed device is designed so the angle of attack of the swing at the top of the back swing is not too steep, therefore the indicator arm does not touch or interfere with the chin. It is only when the swing is too steep in the back swing and/or the golfer swings beyond the three-quarter position at the top of the back swing that the indicator arm of the presently claimed device interferes with the chin. These events can be avoided by maintaining the correct golf swing. The device of the Oppenheimer patent provides a device that physically holds a golfer's body in position such that the golfer cannot move. In contradistinction, the presently claimed device provides a device that shows the golfer the correct method for swinging a club. The Oppenheimer patent does not disclose nor suggest a device that functions or is identical to that of the presently pending independent claims in that the presently pending independent claims do not require the shaft be centered on the body such that the device constrains the golf swing or golf club. Therefore the presently pending independent claims are patentable over the cited prior art.

There is no disclosure in any of the cited references for the device of the presently claimed invention. Additionally, neither the cited references alone or in

combination disclose or suggest the device of the presently claimed invention. Reconsideration of the rejection is respectfully requested.

The remaining dependent claims not specifically discussed herein are ultimately dependent upon the independent claims. References as applied against these dependent claims do not make up for the deficiencies of those references as discussed above. The prior art references do not disclose the characterizing features of the independent claims discussed above. Hence, it is respectfully submitted that all of the pending claims are patentable over the prior art.

In view of the present amendment and foregoing remarks, reconsideration of the rejections and advancement of the case to issue are respectfully requested.

The Commissioner is authorized to charge any fee or credit any overpayment in connection with this communication to our Deposit Account No. 11-1449.

Respectfully submitted,

KOHN & ASSOCIATES, PLLC



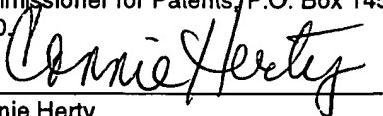
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